



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/020,772 | 12/12/2001 | Roger S. Kerr | 83030NAB | 8661 |

7590 11/04/2003

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

ROSSI, JESSICA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/020,772

Applicant(s)

KERR ET AL.

Examin r

Jessica L. Rossi

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/26/03, Election.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 8-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, Species A (claims 1 and 4-7) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 2-3 and 8-52 are withdrawn from further consideration.
2. Note the examiner made a typo in the written restriction. Claim 9 was inadvertently listed in Group II when it should have been listed in Group I; it being noted that the examiner did correctly group claim 9 under Species A, which is a species within Group I.

Drawings

3. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. See p. 5, lines 23-26 in present specification.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 220, 250, 260, 308, 318, 330, 340, 360, 370, 380, 390. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 8 (see Figure 7). A

Art Unit: 1733

proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is unclear as to what is meant by “creating a pre-press proof.” According to the specification of the present application, a pre-press proof is created by a lamination transfer process (p. 3, lines 20-29). However, the present claim states that laminating takes place during the embossing step, which takes place after the creating step. If Applicants intend for the creating step to mean something other than laminating, it is unclear as to what that is since only lamination techniques are disclosed for creating the pre-press proof. Applicants are asked to clarify.

Regardless of whether or not Applicants intend for the creating step to mean laminating, it is also unclear as to how laminating can take place during the embossing step since the pre-press proof undergoing embossment consists of a proof 200 and an image 290 that was already transferred to the surface of the proof via lamination (p. 7, lines 11-17; Figure 7). Applicants are asked to clarify.

Also regarding claim 1, it is unclear as to what Applicants mean by “and forming a pre-press proof with a thermal mark.” According to the specification and present claim, the embossing step results in formation of a pre-press proof with a thermal mark. However, the present claim language implies that another step, different from the embossing step, forms a pre-press proof with a thermal mark. Applicants are asked to clarify. It is suggested to delete “and forming a pre-press proof with a thermal mark.”

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al. (US 5203942; provided in IDS) in view of the collective teachings of Hicks (US 5359387) and Lopez et al. (US 2003/0020945), Akada et al. (US 5451560), and the collective teachings of Rohleder et al. (US 5429696) and Parker et al. (US 5327825)

With respect to claim 1, it is known in the art to create a pre-press proof (column 3, line 10) using a thermal transfer lamination process, as evidenced by DeCook. The process involves forming an image 38 on the surface of backing layer 39 thereby forming an image transfer layer 34, bringing the image side of the transfer layer into contact with the surface of image reception layer 1a, and applying heat and pressure to laminate the transfer layer to the reception layer such that transfer of the image 38 to the surface of the reception layer takes place, and removing the backing layer from the laminate to form a pre-press proof, as taught by DeCook (column 8, lines

Art Unit: 1733

22-35). However, DeCook is silent as to embossing the surface of the pre-press proof to form a thermal mark thereon using an embossing belt having an embossing mark thereon.

It is known in the proof art to form markings (i.e. numbers, letters, symbols) on the surface of a proof thereby allowing for easy identification of the proofs and/or simplified ordering procedures for the same, as taught by the collective teachings of Hicks (Figure 2; column 2, lines 5-8; column 3, lines 16-17 and 21-40; column 4, lines 42-47) and Lopez (Figure 1a; [0013]; [0037]; [0038]).

Therefore, it would have been obvious to the skilled artisan at the time the invention was made to form markings on the surface of the proof of DeCook because such is known in the art, as taught by the collective teachings of Hicks and Lopez, and this allows for easy identification of the proofs and/or simplified ordering procedures for the same.

It is known in the thermal transfer lamination art to form an image on the surface of a backing layer thereby forming an image transfer layer, bring the image side of the transfer layer into contact with the surface of an image reception layer, and apply heat and pressure to laminate the transfer layer to the reception layer such that transfer of the image to the surface of the reception layer takes place, and removing the backing layer from the laminate to form an imaged substrate, as taught by Akada et al. (abstract; column 1, lines 11-13; column 2, lines 41-42; column 3, lines 16-18; column 16, lines 10-11; column 17, lines 11-12; column 27, lines 45-61; column 28, line 58 – column 29, line 31). Akada also teaches this thermal transfer lamination process being combinable with an embossing step to form markings such as characters and numbers on the surface of the imaged substrate (column 33, lines 55-62).

Art Unit: 1733

It would have been obvious to the skilled artisan at the time the invention was made to form the markings of DeCook in view of the collective teachings of Hicks and Lopez by embossing because such is known in the image transfer art, as taught by Akada, thereby eliminating the need for writing on the proofs which can lead to permanent damage thereof.

As for a particular embossing mechanism, it would have been obvious to the skilled artisan at the time the invention was made to use an embossing belt having the desired marking thereon because such is known in the embossing art for providing a substrate with a thermal marking, as taught by the collective teachings of Rohleder (Figure 5; column 7, lines 48-67) and Parker (column 1, lines 5-7 and 29-31; column 2, lines 20-27 and 48-50), wherein this allows for embossing in a continuous manner thereby expediting the overall process.

10. Claims 4-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al., the collective teachings of Hicks and Lopez et al., Akada et al., and the collective teachings of Rohleder et al. and Parker et al. as applied to claim 1 above, and further in view of Metzger (US 6177234).

Regarding claim 4, DeCook is silent as to the type of image formed on the pre-press proof. Selection of a particular type would have been within purview of the skilled artisan depending on the desired qualities of the proof. However, it would have been obvious to form a monochrome image because such is known in the art, as taught by Metzger (abstract; column 2, line 10; column 6, lines 57-58).

Regarding claim 5, Metzger also teaches forming a multi-colored image (abstract; column 2, line 10; column 6, lines 57-58).

Regarding claim 7, DeCook is silent as to the pre-press proof being a dual sided one. It would have been obvious to form a dual sides pre-press proof for the proof of DeCook because such is known in the art, as taught by Metzger (column 2, lines 51-53; column 3, lines 56-57; column 5, lines 21-22), and this allows for cost reduction since the number of image reception layers can be reduced by half.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeCook et al., the collective teachings of Hicks and Lopez et al., Akada et al., and the collective teachings of Rohleder et al. and Parker et al. as applied to claim 1 above, and further in view of Hoisington et al. (EP 0949081).

Regarding claim 6, DeCook is silent as to how the image is formed. One reading the reference as a whole would have appreciated that such is not critical to the invention and therefore selection of a particular method would have been within purview of the skilled artisan. However, it would have been obvious to form an inkjet-generated image because such is known in the art, as taught by Hoisington (column 1, lines 12-13 and 19-21).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419** (571-272-1223 come mid December). The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 10/020,772

Page 8

Art Unit: 1733

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



JEFF H. AFTERGUT
PRIMARY EXAMINER
GROUP 1300